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| 10/596,806 | 06/25/2006 | Jose Maria Isenser Farre | 460582.000007 | 1705 |
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| Nixon Peabody LLP 200 Page Mill Road Suite 200 Palo Alto, CA 94306 | | | | |
| EXAMINER | | | | |
| YEUNG, MANG HANG | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/596,806

Applicant(s)

ISENSER FARRE ET AL.

Examiner

MANG YEUNG

Art Unit

2416

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. The instant application having Application No. 10/596806 filed on 06/25/2006 is presented for examination by the examiner.

Claim Objections

2. Claims 1, 4 are objected as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrase "adapts to" renders the claim indefinite because it is unclear whether the steps recited after the phrase "adapts to" be optional steps or necessary steps for the claim invention.

Regarding claim 4, the word "screams" which appears to be a misspelling of the word "streams".

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 - 5 are rejected as failing to define the invention in the manner required by 35 U.S. 112, second paragraph.

Claims 1 - 5 are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device.

5. **Claim 2** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitations “**the transaction**”, “**the processor**” and “**the peripherals**”. There are insufficient antecedent basics for these limitations in the claim.

In addition, regarding **claim 2**, the phrases “**may be originated by the processor**” render the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. Thus, it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 1, 2** are rejected under 35 U.S.C. 102(b) as being anticipated by Inoue (US Patent Publication # 2003/0005441 A1).

As per **claim 1**, Inoue discloses “**Circuit integrated in a receiver system for digital television networks, characterized by the fact that it can process the flow**

of data from one or several MPEG data streams with different functions so that it adapts to receiver applications and to multimedia information servers (video, audio and data)" as [(fig. 1 and par. 0031 - 0035), satellite television receiver.]

As per **claim 2**, Inoue discloses **"The circuit that constitutes this invention"** as [(See rejection of claim 1)]

Inoue discloses **"is characterized by its versatility since it incorporates a single internal bus structure"** as [(fig. 1), single bus] **"in which the transactions may be originated by the processor embedded into the circuit or by the peripherals"** [(fig. 1 and par. 0035), CPU 17.]

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. **Claim 4** is rejected under 35 U.S.C. 102(e) as being anticipated by Calder et al. (US Patent # 5872784).

As per **claim 4**, Calder discloses **"The invention is characterized by a specific switching function between two or more conditional access systems Even though it has been described for the case of 2 conditional accesses over 2 independent**

data streams, the current claim can be extrapolated to any number of conditional accesses and data streams” [(fig. 1 and col. 5 – lines 4 to 7), MPEG streams 110 including a video stream 112, an audio stream 114, and a data stream 116. These three streams are then processed by conditional access subsystem 118.]

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. **Claim 3** is rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue (US Patent Publication # 2003/0005441 A1) in view of Yoshioka (US Patent # 7079583 B2).

As per **claim 3**, Inoue discloses **“In addition, the circuit that constitutes this invention”** as [(See rejection of claim 2)]

Inoue does not expressly disclose “is characterized by the fact that it incorporates subsystems with routing and processing functions implemented by hardware and software, and used as modules that comprise the possible circuit configurations”.

However, Yoshioka discloses **“is characterized by the fact that it incorporates subsystems with routing and processing functions implemented by hardware and**

software, and used as modules that comprise the possible circuit configurations" as [(fig. 4 and col. 11 – lines 40 to 41), the routine processing unit 1004.]

Inoue (US Patent Publication # 2003/0005441 A1) and Yoshioka (US Patent # 7079583 B2) are analogous art because they are the same field of endeavor of network communication.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Yoshioka's teaching into Inoue's teaching. The motivation for making the above modification would be to improve a media processing apparatus which can efficiently execute a huge amount of processing. (Yoshioka, col. 2 – lines 29 - 51)

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Calder et al. (US Patent # 5872784) in view of Bigham et al. (US patent # 5544161).

As per **claim 5**, Calder discloses **"The invention is characterized by the fact that is it easily configurable, allowing at least the following functionalities:"** as [(fig. 1), digital television and digital television receiver.] **"1 - Processing of two input data streams to two output data streams;"** [(fig. 1), input streams 112, and 114/output streams 124 and 125] **"2 - Processing of one input data stream (ITSINB) and one internally-synthesized data stream from the processor (PROC) to two output data streams;"** [(fig. 1), MPEG 2 stream 106/streams 112 and 114] **"3 - Processing of one input data stream (ITSINB), and one data stream from a local**

network access (ILAN), to two output data streams" [(fig. 1), input streams 112, and 114/output streams 124 and 125.]

Calder does not expressly disclose "4 - Processing of two data streams, both from a local network connection (ILAN), to two output data streams; and 5 - Processing of two input data streams (ITSINA and ITSINB) to a local network concentrator/multiplexor".

However, Bigham discloses "**4 - Processing of two data streams, both from a local network connection (ILAN), to two output data streams;**" as [(col. 29 – lines 10 to 12), The transport MUX 762 multiplexes the input MPEG streams to one of five output 27 MB/s transport streams.] "**and 5 - Processing of two input data streams (ITSINA and ITSINB) to a local network concentrator/multiplexor"** [(col. 29 – lines 10 to 12), The transport MUX 762 multiplexes the input MPEG streams to one of five output 27 MB/s transport streams.]

Calder et al. (US Patent # 5872784) and Bigham et al. (US patent # 5544161) are analogous art because they are the same field of endeavor of network communication.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Bigham's teaching into Calder's teaching. The motivation for making the above modification would be to improve the flexibility, efficiency of a signaling communication system. (Bigham, col. 7 – lines 34 - 47)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MANG YEUNG whose telephone number is (571)270-7319. The examiner can normally be reached on Mon to Th (9:00am to 5:00pm EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derrick W. Ferris can be reached on 571 272 3123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M.Y./

/Derrick W Ferris/

Supervisory Patent Examiner, Art Unit 2416